

REMARKS**Summary of the Office Action**

In the Office Action, claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,881,032 to Ito et al. (hereinafter “Ito”) in view of U.S. Patent No. 6,128,272 to Horimai et al. (hereinafter “Horimai”).

Summary of the Response to the Office Action

Applicant has amended claims 1-9, 11, and 13-18 to improve the form of the claims. New claims 22-26 have been added to differently describe the invention and to afford the Applicant scope to which he is entitled. Accordingly, claims 1-26 are now pending in this application for consideration.

Rejection under 35 U.S.C. § 103(a)

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Horimai. This rejection is respectfully traversed for at least the following reasons.

Applicant respectfully submits that claim 1 recites an optical recording medium combination having a double-spiral structure. In particular, claim 1 recites an “optical recording medium having a plurality of recording layers of a double-spiral structure in which information is to be recorded on both of land tracks and groove tracks.”

Applicant respectfully submits that the applied art of record, whether taken separately or in combination, do not teach or suggest such a double-spiral structure, as described, for example, in independent claim 1 of the instant application. In this regard, Applicant respectfully submits

that Ito merely discloses a single spiral structure in which information is only recorded on grooves. Moreover, Applicant respectfully submits that Horimai merely discloses a ROM disk. While the ROM disk disclosed by Horimai includes a plurality of pits, it does not include any lands or grooves. See, for example, col. 19, line 34 – col. 20, line 43 of Horimai. As a result, Applicant respectfully submits that Ito and Horimai, whether taken separately or in combination, do not teach or suggest “a double-spiral structure in which information is to be recorded on both of land tracks and groove tracks.” As a result, Applicant respectfully submits that even assuming, *strictly arguendo*, that one skilled in the relevant art would be motivated to combine the disclosures of Ito and Horimai in the manner suggested by the Office Action, the novel combination recited in independent claim 1 would still not be obtained because the above-mentioned features would still not be met. Applicant respectfully submits that the remaining independent claims 2 and 17-21 are allowable for similar reasons as those set forth above with regard to independent claim 1.

It is respectfully submitted that the amendments made to the claims in the instant amendment are not being made for purposes of patentability, but instead are merely being made to improve the form of the claims.

Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither Ito nor Horimai, whether taken singly or combined, teach or suggest each feature of independent claims 1, 2 and 17-21. MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” Furthermore, Applicant respectfully asserts that dependent claims 3-16 are allowable at least because of their dependence from claims 1 or 2, and the reasons set forth above.

Newly-Added Claims

New claims 22-26 have been added to differently describe the invention and to afford the Applicant scope to which he is entitled. These newly-added claims are in condition for allowance for similar reasons as those set forth above with regard to independent claim 1.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the timely allowance of this application. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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